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10/045,158	01/15/2002	Yosato Hitaka	03500.016099.	8868
5514 7590 03/09/2009 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER				
MEMBERU, BENIYAM				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/045,158

**Applicant(s)**

HITAKA, YOSATO

**Examiner**

BENIYAM MENBERU

**Art Unit**

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 20, 24, 25, 27 and 29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20, 24, 25, 27 and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 15, 2008 has been entered.

***Claim Objections***

2. Claim 24 is objected to because of the following informalities: In claim 24, last line "of a the selected print shop" should be changed to "of the selected print shop". Appropriate correction is required.
3. Claim 27 is objected to because of the following informalities: In claim 27, last line "of a selected print shop" should be changed to "of the selected print shop". Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 20, 24, 25, 27, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7441003 to Takeda et al in view of U.S. Patent No. 6822754 to Shiohara further in view of JP 2000-163237 to Migishima.

Regarding claim 20, Takeda et al '003 discloses a user apparatus that communicates with a print management apparatus via a network (Figure 1 shows user apparatus 12 and print manager 16; column 8, lines 62-67; column 9, lines 33-44), comprising:

notifying means for notifying said print management apparatus of a use condition which is set according to an operation of a user, the use condition including information for designating an area where a print shop having a print apparatus is located (column 10, lines 19-22, 31-46; "search condition" can be location information such as "Tokyo");

print shop information obtaining means for obtaining, in advance, print shop information for a plurality of print shops each satisfying the notified use condition, from said print management apparatus (column 10, lines 47-57; terminal 12 receives the search result which includes mail address, location, pricing information about the printers; column 11, lines 20-41). However Takeda et al '003 does not disclose

print data forming means for forming single print data by using a printer driver installed in said user apparatus, in accordance with a print condition which is set according to the operation of the user, the print condition being different from the use condition and not including the information for designating the area where the print shop having the print apparatus is located;

judgment means for analyzing the single print data formed by said print data forming means, and automatically judging whether each of the plurality of print shops included in the print shop information obtained in advance by said print shop information obtaining means can print said single print data, on the basis of the print condition of the single print data and a print ability of each of the plurality of print shops;

selection means for selecting, in accordance with a user operation, a print shop to order print processing of said single print data formed by said print data forming means, from among the print shops judged by said judgment means as the print shops which can print the formed print data; and

print order forming means for forming a print order, including the designation of the selected print shop.

Shiohara '754 discloses print data forming means for forming single print data by using a printer driver (column 7, lines 34-42, 52-55; driver 24) installed in said user apparatus (column 4, lines 21-29), in accordance with a print condition which is set according to the operation of the user (column 11, lines 36-42), the print condition being different from the use condition and not including the information for designating the area where the print shop having the print apparatus is located (column 9, lines 56-64; temporary print request (print data) does not include area information for print shop);

judgment means for analyzing the single print data formed by said print data forming means (column 4, lines 8-11), and automatically judging whether each of the plurality of print shops included in the print shop information obtained in advance by said print shop

information obtaining means can print said single print data, on the basis of the print condition of the single print data and a print ability of each of the plurality of print shops (column 14, lines 27-43; The "print processing information" of all printers 31 is obtained (print shop information) in response to the temporary print request (print data formed; see (column 9, lines 52-67)) submitted to all the printers. Each printer 31 is judged to be match for print data based on printing content ("print condition") and printer 31 status (print ability). (column 14, lines 44-52; column 11, lines 6-67; column 12, lines 1-5).);

selection means for selecting, in accordance with a user operation, a print shop to order print processing of said single print data formed by said print data forming means, from among the print shops judged by said judgment means as the print shops which can print the formed print data (column 14, lines 52-67; column 15, lines 22-39; printer is selected in step 47. column 15, lines 39-43; print request to specific printer (designation of the selected shop)). User can make the final selection of printer as shown in steps s49, s51, s52 if user doesn't like the automatic selection of step s47); and

print order forming means for forming a print order, including the designation of the selected print shop (column 15, lines 39-43; print request to specific printer (designation of the selected shop)).

Having the system of *Takeda et al '003* and then given the well-established teaching of *Shiohara '754*, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of *Takeda et al '003* as

taught by **Shiohara '754**, since **Shiohara '754** stated in col. 2, Lines 11-30, such a modification would provide a faster printing system in a printing network.

However Takeda et al '003 does not disclose plurality of print shops as candidates of print shops to be designated by respective print orders of a plurality of print data different from each other.

Migishima '237 discloses plurality of print shops as candidates of print shops to be designated by respective print orders of a plurality of print data different from each other (see Abstract section: plural jobs; paragraph 38, 39, 40, 41; print jobs can be different (color, monochrome, ...)).

Having the system of **Takeda et al '003** and then given the well-established teaching of **Migishima '237**, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of **Takeda et al '003** as taught by **Migishima '237**, since **Migishima '237** stated in Abstract and paragraph 74, 75, such a modification would provide fast print output system for multiple print jobs/orders.

Regarding claim 24, Takeda et al '003 discloses an information processing system for processing information between a user apparatus and a print management apparatus through communication via a network (Figure 1 shows user apparatus 12 and print manager 16; column 8, lines 62-67; column 9, lines 33-44), wherein said print management apparatus comprises:

print shop information searching means for searching for information of a plurality of print shops (column 10, lines 46-55); and

print shop information transmitting means for transmitting the print shop information searched by the print shop information searching means to said user apparatus (column 10, lines 46-57; manager server 16 transmits printer information to user device 12), and

wherein said user apparatus comprises:

notifying means for notifying said print management apparatus of a use condition which is set according to an operation of a user, the use condition including information for designating an area where a print shop having a print apparatus is located (column 10, lines 19-22, 31-46; "search condition" can be location information such as "Tokyo");

print shop information obtaining means for receiving, from the print shop information transmitting means, print shop information for the plurality of print shops searched by the print shop searching means each satisfying the notified use condition (column 10, lines 47-57; terminal 12 receives the search result which includes mail address, location, pricing information about the printers; column 11, lines 20-41)

However Takeda et al '003 does not disclose:

print data forming means for forming single print data by using a printer driver installed in said user apparatus, in accordance with a print condition which is set according to an operation of the user, the print condition being different from the use condition and not

including the information for designating the area where the print shop having the print apparatus is located;

judgment means for analyzing the single print data formed by said print data forming means, and automatically judging whether each of the plurality of print shops included in the received print shop information can print said single print data on the basis of the print condition of the print data and a print ability of each of the plurality of print shops;

selection means for selecting, in accordance with a user operation, a print shop to order print processing of said single print data formed by said print data forming means, from among the print shops judged by said judgment means as the print shops which can print the formed print data; and

a print order forming means for forming a print order, including the designation of a the selected print shop.

Shiohara '754 discloses:

print data forming means for forming single print data by using a printer driver (column 7, lines 34-42, 52-55; driver 24) installed in said user apparatus (column 4, lines 21-29), in accordance with a print condition which is set according to an operation of the user (column 11, lines 36-42), the print condition being different from the use condition and not including the information for designating the area where the print shop having the print apparatus is located (column 9, lines 56-64; temporary print request (print data) does not include area information for print shop);

judgment means for analyzing the single print data formed by said print data forming means (column 4, lines 8-11), and automatically judging whether each of the plurality of print shops included in the received print shop information can print said single print data on the basis of the print condition of the print data and a print ability of each of the plurality of print shops (column 14, lines 27-43; The "print processing information" (print shop information) of all printers 31 is obtained in response to the temporary print request (print data formed; see (column 9, lines 52-67)) submitted to all the printers. Each printer 31 is judged to be match for print data based on printing content ("print condition") and printer 31 status (print ability). (column 14, lines 44-52; column 11, lines 6-67; column 12, lines 1-5).);

selection means for selecting, in accordance with a user operation, a print shop to order print processing of said single print data formed by said print data forming means, from among the print shops judged by said judgment means as the print shops which can print the formed print data (column 14, lines 52-67; column 15, lines 22-39; printer is selected in step 47. column 15, lines 39-43; print request to specific printer (designation of the selected shop). User can make the final selection of printer as shown in steps s49, s51, s52 if user doesn't like the automatic selection of step s47); and

a print order forming means for forming a print order, including the designation of the selected print shop (column 15, lines 39-43; print request to specific printer (designation of the selected shop)).

Having the system of **Takeda et al '003** and then given the well-established teaching of **Shiohara '754**, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of **Takeda et al '003** as taught by **Shiohara '754**, since **Shiohara '754** stated in col. 2, Lines 11-30, such a modification would provide a faster printing system in a printing network.

However Takeda et al '003 does not disclose plurality of print shops as candidates of print shops to be designated by respective print orders of a plurality of print data different from each other.

Migishima '237 discloses plurality of print shops as candidates of print shops to be designated by respective print orders of a plurality of print data different from each other (see Abstract section: plural jobs; paragraph 38, 39, 40, 41; print jobs can be different (color, monochrome, ...)).

Having the system of **Takeda et al '003** and then given the well-established teaching of **Migishima '237**, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of **Takeda et al '003** as taught by **Migishima '237**, since **Migishima '237** stated in Abstract and paragraph 74, 75, such a modification would provide fast print output system for multiple print jobs/orders.

Regarding claim 25, see Rejection of claim 20 as shown above. The apparatus of Takeda et al '003 in view of Shiohara '754 further in view of Migishima '237 renders obvious the programming steps of claim 25.

Regarding claim 27, see Rejection of claim 20 as shown above. The apparatus of Takeda et al '003 in view of Shiohara '754 further in view of Migishima '237 renders obvious the method steps of claim 25.

Regarding claim 29, Takeda et al '003 in view of Shiohara '754 further in view of Migishima '237 teaches all the limitations of claim 20. Further Shiohara '754 discloses an apparatus according to claim 20, wherein each of the use condition and the print ability includes at least one of a page size, a media type, a page layout and a finishing option (column 11, lines 58-65; color is a "finishing option").

### ***Other Prior Art Cited***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 7242491 to Nakayasu et al disclose print system.

U.S. Patent No. 7096280 to Aoki et al disclose print system on network.

JP 10-191453 to Taki disclose print output system.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENIYAM MENBERU whose telephone number is (571) 272-7465. The examiner can normally be reached on 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is (571) 272-2600. The group receptionist number for TC 2600 is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

### ***Patent Examiner***

Beniyam Menberu

/Beniyam Menberu/  
Examiner, Art Unit 2625

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/David K Moore/

Supervisory Patent Examiner, Art Unit 2625